

**REMARKS**

**I. Introduction**

By this amendment, claims 64-73, and 85-89 are cancelled without prejudice thereto, claims 1 and 74 are amended to overcome the rejections based on non-statutory subject matter, claims 1, 24, 33, 55, 74 and 90 are amended to more clearly distinguish over the art of record, claim 2 is amended to correct a minor informality and new claims 100 to 102 are added. No new matter has been added by this amendment.

Reconsideration in view of the foregoing amendments and following remarks is respectfully requested.

**II. Personal Interview**

Applicants appreciate the courtesies extended to Applicant Loren Eckert and Applicants' representative during the November 18, 2005 Personal Interview with Examiner Colon. During the Interview, Applicants representative presented proposed claim amendments to distinguish over the art of record. After viewing Applicant's demonstration of the system embodied by the claims, Examiner Colon also suggested additional claim changes that could distinguish over the art of record. The claim changes made by this amendment reflect the substance of what was discussed during the Interview.

**III. Minor Informalities**

The Examiner has objected to claim 2 as depending upon itself. By this amendment, claim 2 has been amended to change its dependency to claim 1. Accordingly, withdrawal of the objection to claim 2 is respectfully requested.

**IV. Rejections under 35 U.S.C. § 101**

Claims 1-23 and 74-89 stand rejected under 35 U.S.C. § 101 as containing non-statutory subject matter. Specifically, the Examiner has stated that these claims fail to define an invention that is within the technological arts. In order to overcome this

rejection, Applicants have amended independent claims 1 and 74 to include the required statutory use of technology.

Regarding claim 1, this claim has been amended to include the steps of obtaining performance information associated with a business, including financial performance information of the business, and storing the information as electronic data on a data processing system, the performance information having a first format based on a first set of performance classifications, converting, using an automated process executing on the data processing system, the performance information from the first format to a second format based at least in part on a mapping of one or more performance classifications of the first set of performance classifications to one or more respective performance classifications of a second set of standardized performance classifications; and analyzing the converted performance information based at least in part on one or more performance metrics, and generating at least one electronic report based on the results of the analyzing.

Regarding claim 74, this claim has been amended to include the steps of storing performance information, including financial performance information associated with a plurality of different businesses as electronic data on a data processing system and generating at least one electronic report illustrating the results of the benchmarking.

Applicants respectfully submit that these additional steps amended into claims 1 and 74 respectively render the claim within the statutory technical arts because the use of technology manipulates the data in a meaningful and non-trivial way. Accordingly, withdrawal of the rejection of these claims under § 101 is respectfully requested.

**V. Rejections under 35 U.S.C. §§ 102(a)/(e) and 103(a)**

Claims 1, 2, 7-15, 21, 23-27, 30, 32-46, 52, 54-58, 61, 63-82, 84-97 and 99 stand rejected under 35 U.S.C. § 102(a)/(e) over U.S. Patent 6,556,974 to D'Alessandro (hereinafter "the '974 patent"); and claims 3-6, 16-20, 22, 28, 29, 31, 47-51, 53, 59, 60, 62, 83 and 90 stand rejected under 35 U.S.C. § 103(a) over the '974 patent. Based on the

amendments made above to independent claims 1, 24, 33, 55, 74, and 90, Applicants respectfully traverse the rejections.

In particular, Applicants submit that the '974 patent fails to disclose or even suggest obtaining, mapping or storing performance information associated with a business, including financial performance information of that business originating from a financial accounting software system used by that business, or that the converted performance information is analyzed in accordance with one or more performance metrics, as recited in each of independent claims 1, 24, 33, 55, 74, and 90. Support for the claim term "financial accounting systems" may be found at paragraph 59 of the original specification. The inventions defined by these claims are all directed to systems and method for obtaining, converting, standardizing, analyzing, and in some cases benchmarking, business performance information including financial data on the business with whom the data is associated. This data includes financial statement data, such as general ledger, cash flow, or other financial statement data that is typically obtained from the general ledger accounting system used by the business. While this data is mainly financial accounting data, this data may also include operational data, such as number of square feet, number of employees, etc., that, in some cases can not be automatically derived from a financial statement. This data is purely objective, that is, it is not based on the opinions of the submitter. Rather the submitter merely facilitates the submission of the business's actual performance data, i.e., from the business's accounting system or predetermined operational characteristics of the business.

In contrast, the system described in the '974 patent is an automated system for obtaining performance information on an organization through employee and non-employee (consultant) surveying. Survey participants are requested to anonymously provide their own subjective opinion on various aspects of the *performance* of a business organization. This includes information such as answers to questions like "is the leadership of this company effective" and "are you satisfied with this company," etc. The type of "performance information" gathering system of the '974 patent attempts to "quantify" the performance of the business based on anonymous aggregate survey

responses that reveal how the employees believe that their company is doing. Even though this information is aggregated, analyzed and even benchmarked against similarly gathered information on other companies, this abstract similarity to the claims of the instant application does not render those claims obvious. Nowhere in the '974 is there disclosure or suggestion of gathering actual business performance data including financial data originating from a business's financial accounting software system, sometimes also referred to in the industry as a general ledger accounting system. The system of the '974 patent is incompatible with gathering this type of data because this data needs to be an accurate reflection of the current financial situation of the business. Information such as that gathered in the systems and methods of the '974 patent has no relation to generally accepted accounting principles. Self-assessment is inherently incompatible with these principles. In the system defined by Applicants' claims, the only human involvement is in physically uploading or otherwise transferring/entering the electronic data into the system. The user supplies the data, but he/she does not create the data. The data is data that comports with generally accepted accounting principles. The data already exists and is not subjective. This is a fundamental difference between the system described in the '974 patent and that of the claims of the instant application.

Another distinction between the '974 patent and the claims of the instant application is that the latter recite analyzing the converted data in accordance with one or more performance metrics. Performance metrics as used in the instant application are defined for example at paragraph 34 of the specification to mean various raw or derived financial attributes or standard financial accounts, such as, for example, cash, total revenue, cost of labor, revenues etc. The Examiner has analogized performance metrics as used in the claims to the Malcolm Baldrige criteria described in the '974 patent that is used as a basis for the scorecard for a businesses total quality output that is derived from the survey responses in the '974 patent. As noted in that patent, the Malcolm Baldrige assessment consists of seven criteria: (1) leadership, (2) strategic planning, (3) customer and market focus, (4) information and analysis, (5) human

resource development and management, and (7) business results. Thus, unlike the instant application, these criteria are used to qualify intangibles, not actual financial performance. The mere mention of a "business results" criteria in the absence of any information suggesting that hard financial data is used to derive this does not render obvious the use of performance metrics in the instant application.

Though limitations in the specification should not be read into the claims where those limitations fail to appear in the claims themselves, where such limitations are recited in the claims, interpretation of those claim limitations should be performed in the context of their definition in the specification. In the recent Federal Circuit decision, Phillips v. AWH Corp., 415 F.3d 1303 (Fed. Cir. 2005), the Court rejected claim construction based on dictionary definitions that fails to consider the context provided by the specification. The Court's decision cracked down on what they labeled as "dictionary abuse" and affirmed that claims are to be construed in the first instance with respect to the specification and the prosecution history. The Court stated that the inquiry into how a person of ordinary skill in the art understands a claim term provides an objective baseline from which to begin claim interpretation. See Innova, 381 F.3d at 1116. That starting point in construing claims is based on the well-settled understanding that inventors are typically persons skilled in the field of the invention and that patents are addressed to and intended to be read by others of skill in the pertinent art. See Verve, LLC v. Crane Cams, Inc., 311 F.3d 1116, 1119 (Fed. Cir. 2002) (patent documents are meant to be "a concise statement for persons in the field"); In re Nelson, 47 C.C.P.A. 1031, 280 F.2d 172, 181, 1960 Dec. Comm'r Pat. 369 (CCPA 1960) ("The descriptions in patents are not addressed to the public generally, to lawyers or to judges, but, as § 112 says, to those skilled in the art to which the invention pertains or with which it is most nearly connected.")

Importantly, the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification.

The court explained that point well in Multiform Desiccants, Inc. v. Medzam, Ltd., 133 F.3d 1473, 1477 (Fed. Cir. 1998):

It is the person of ordinary skill in the field of the invention through whose eyes the claims are construed. Such person is deemed to read the words used in the patent documents with an understanding of their meaning in the field, and to have knowledge of any special meaning and usage in the field. The inventor's words that are used to describe the invention--the inventor's lexicography--must be understood and interpreted by the court as they would be understood and interpreted by a person in that field of technology. Thus, the court starts the decision making process by reviewing the same resources as would that person, viz., the patent specification and the prosecution history.

See also Medrad, Inc. v. MRI Devices Corp., 401 F.3d 1313, 1319 (Fed. Cir. 2005) ("We cannot look at the ordinary meaning of the term . . . in a vacuum. Rather, we must look at the ordinary meaning in the context of the written description and the prosecution history."); V-Formation, Inc. v. Benetton Group SpA, 401 F.3d 1307, 1310 (Fed. Cir. 2005) (intrinsic record "usually provides the technological and temporal context to enable the court to ascertain the meaning of the claim to one of ordinary skill in the art at the time of the invention"); Unitherm Food Sys., Inc. v. Swift-Eckrich, Inc., 375 F.3d 1341, 1351 (Fed. Cir. 2004) (proper definition is the "definition that one of ordinary skill in the art could ascertain from the intrinsic evidence in the record"). Phillips v. AWH Corp., 415 F.3d 1303, 1314 (Fed. Cir. 2005)

In the Phillips opinion, the Federal Circuit reiterated the principle that patent "claims" define the metes and bounds of the patentee's property right, much like a deed to a piece of land. Heavy reliance on the dictionary divorced from the intrinsic evidence risks transforming the meaning of the claim term to the artisan into the meaning of the term in the abstract, out of its particular context, which is the specification.

Thus, interpreting the claims of the instant application from the perspective of the person of ordinary skill in the art, in light of the teaching of the specification, it becomes clear that claim language specifying performance metrics is clearly different

from the Malcolm Baldrige criteria used in the '974 patent. Malcolm Baldrige criteria is mainly a tool of TQM, a field that is completely different than accounting.

Therefore, because the '974 patent fails to teach each and every element of the claimed invention either explicitly or implicitly, the rejection under § 102 is improper. In addition, because of the fundamental and explicit differences between the '974 patent and the amended claims that are discussed above, Applicants submit that these claims would not have been obvious in view of the '974 patent at the time of the invention. Therefore a rejection of these claims under § 103 would also be improper. Thus, Applicants respectfully submit that claims 1, 2, 7-15, 21, 23-27, 30, 32-46, 52, 54-58, 61, 63-82, 84-97 and 99 are patentable over the '974 patent. Accordingly, withdrawal of the rejection under § 102(a)/(e) is respectfully requested.

Regarding the rejection of dependent claims 3-6, 16-20, 22, 28, 29, 31, 47-51, 53, 59, 60, 62, 83 and 98 under 35 U.S.C. § 103(a), Applicants respectfully submit that these claims are patentable over the '974 patent for at least the same reasons as independent claims 1, 24, 33, 55, 74 and 90 as discussed above. Accordingly, withdrawal of the rejection under § 103(a) is respectfully requested.

## VI. New Claims 100-102

New claim 100 recites a method for automated management of performance information associated with a plurality of business, the method comprising, *inter alia*, obtaining performance information associated with a plurality of different businesses from a third party who maintains performance information on multiple different businesses originating from financial accounting systems used by the multiple different businesses, the performance information having a having a third party-defined format, and, after converting the information to a standardized format, analyzing that information in accordance with one or more performance metrics. As discussed above, Applicants submit that the art of record fails to suggest or disclose obtaining business performance information originating from financial accounting systems.

New claim 101 recites a network-based business performance information management system comprising a computer system accessible on a computer network and adapted to, *inter alia*, electronically receive at least one business performance information file from at least one business, the business performance information file containing financial statement information taken from that business' financial accounting software system on the on the at least one business in a first format, and after converting the business performance information from the first format to a standardized format, analyzing the converted performance information based at least in part on one or more performance metrics. As discussed above in the context of the rejections under §§ 102, 103, this feature is neither disclosed or suggested in the '974 patent. Thus, claims 100 and 101 are believed to define patentable subject matter.

New claim 102 recites a method for gathering business performance information comprising, *inter alia*, electronically receiving a file containing trial balance information associated with a business from that business' financial accounting software system in a first format at a remote computer system over the Internet. Applicants submit that there is no disclosure or suggestion of receiving a file containing trial balance information in the '974 patent. A trial balance is a specific granular financial report known the art of financial accounting. Obtaining trial balance information is neither disclosed or suggested in the art of record. Thus, claim 102 is also believed by Applicants to define patentable subject matter.




## VII. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully submit that all pending claims are in a condition for allowance. Favorable reconsideration and prompt allowance of all pending claims are earnestly solicited. Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

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